

member that is moveable, relative to the one of the snowboard boot or the snowboard binding on which the active engagement member is located, between an open position and a closed position, the method comprising a step of:

(A) stepping the snowboard boot out of the snowboard binding so that the active engagement member automatically moves from the closed position to the open position without operating a lever on the snowboard boot or the snowboard binding, so that the first engagement member is disengaged from the second engagement member.

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16. (Amended) The method of claim [74] 75, wherein the step (B) includes a step of stepping the snowboard boot into the snowboard binding so that the first engagement member is brought substantially straight down on top of the second engagement member.

Please add the following claim:

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78. (New) The method of claim 73, wherein the snowboard binding further includes a third moveable engagement member to engage the snowboard boot and an actuator, coupled to the third engagement member, to move the third engagement member to a release position wherein the third engagement member does not engage the boot, and wherein the method further comprises, prior to performing the step (A), a step of actuating the actuator to move the third moveable engagement member to the release position to enable the snowboard boot to be stepped out of engagement with the snowboard binding.

#### REMARKS

In response to the Office Action dated January 12, 2000, Applicants respectfully request reconsideration. To further the prosecution of this application, amendments have been made in the claims, and the claims as presented are believed to be in allowable condition.

In ¶2, the Office Action indicates that numerous references cited in the IDS filed August 3, 1998 have not been considered, as no copies were provided as set forth in 37 C.F.R. §1.98(a)(2). Applicants' records indicate that copies of the references were filed with the IDS. Nevertheless, the IDS is being resubmitted herewith with copies of the cited references.

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In ¶3, the Office Action asserts that Applicants have not complied with 35 U.S.C. §120 with respect to related application 08/887,530, indicating that the related application should be referenced as a continuation-in-part. In addition, the Office Action proposes alternate language for referencing the related provisional applications. The cross-referencing paragraph has been amended in accordance with the Examiner's suggestions.

In ¶6, the Office Action objects to the drawings as not complying with the specification. In response, the reference character at page 21, line 28 has been corrected to --103-- as suggested by the Examiner, and a proposed revised Fig. 29 is included with reference character C added for the arrow.

In ¶8, the Office Action objects to the specification incorporating by reference the material in application 08/887,530 in view of the previous reference to the present application being a continuation of that related application. It is believed that this issue has been resolved by changing the cross-reference to describe the present application as being a continuation-in-part of that related application.

#### Rejections under 35 U.S.C. §112

In ¶10, a number of claims were rejected under 35 U.S.C. §112 as being indefinite. In particular, claims 23, 24, 28, 29, 48 and 54 were rejected for lacking clear antecedent basis for certain terms recited therein. Each of these claims has been amended to address this issue.

In addition, claims 45 and 46 were rejected as purportedly being unclear as to whether they are directed to a snowboard boot, or a snowboard boot in combination with a binding. This rejection is respectfully traversed, as Applicants believe that the claims are clearly directed to a snowboard boot. The reference in the claims to features of the binding are not part of the claimed subject matter, but rather recite something analogous to a work piece with which the claimed snowboard boot cooperates.

Claim 51 was rejected as being unclear as to whether the first and second engagement members are different from the active and compatible engagement members. Claim 51 has been amended to address the Examiner's concern.

Claims 55, 64-65, 68 and 73 were rejected as being unclear as to whether they are directed to a snowboard binding, or a snowboard binding in combination with a boot. As with

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the rejection of claims 45-46 discussed above, this rejection is respectfully traversed, as Applicants believe that each of these claims is clearly directed to a snowboard binding, with any reference to the boot merely being analogous to a work piece that helps to define the structural characteristics of the claimed snowboard binding.

Finally, claim 76 was rejected as lacking clear antecedent basis for the step (B). The dependency of claim 76 has been amended to correct this deficiency.

#### The Double Patenting Rejections

In ¶s 12-14, each of the claims is provisionally rejected under the judicially created document of double patenting over the claims of three commonly assigned co-pending applications which share a common specification. The rejections indicate that the subject matter claimed in the present application is fully disclosed in the co-pending applications and would be covered by any patent granted from those applications. Applicants respectfully disagree, as the independent claims in this series of co-pending applications claim patentably distinct concepts. However, in view of the fact that the double patenting rejections are only provisional in nature, Applicants defer response until such time as the rejections are actually made.

#### Allowable Subject Matter

In ¶19, the Office Action indicates that a number of dependent claims, including claims 24, 44 and 73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of their base claims and any intervening claims. Claims 24 and 73 have been so rewritten. In addition, the limitations from claim 44 have been added to claim 33 (its base claim with no intervening claims). Therefore, it is respectfully submitted that claims 24, 33 and 73 are now in condition for allowance.

#### Rejections Under 35 U.S.C. §102 Over Bader

Applicants have obtained a translation of Bader, a copy of which is enclosed for the Examiner's convenience. As discussed at page 3, lines 17-20 and page 9, lines 3-5 of the

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translation, Bader discloses a "safety binding" that releasably connects the rider to a snowboard, so that the binding may release in the event of a fall during riding. Each of Applicants' independent claims has been amended to be directed to a non-releasable system to clearly distinguish over Bader. Support for these amendments can be found, for example, at page 38, line 30 of the specification.

Independent claim 1 has been amended to recite the first and second engagement members (one of which is mounted to the snowboard boot and the other of which is mounted to the binding) as being adapted to engage to prevent release of the toe area of the boot from the binding during riding. Thus, the rejection of claim 1 under 35 U.S.C. §102 as being anticipated by Bader should be withdrawn. Claims 2-23 and 25-32 depend from claim 1 and are patentable for at least the same reasons.

Independent claim 33 has been amended to incorporate the limitations of claim 44, which the Examiner has indicated as allowable. Therefore, claim 33, as well as claims 34-43 and 45-50 that depend therefrom, patentably distinguishes over Bader and is in condition for allowance.

Independent claim 51 has been amended to recite the active engagement member as engaging the compatible engagement member to prevent release during riding. As discussed above in connection with claim 1, Bader teaches a safety binding that is designed to release during riding. Therefore, claim 51 patentably distinguishes over Bader, and the rejection of claim 51 under 35 U.S.C. §102 as being anticipated by Bader should be withdrawn. Claims 52-53 depend from claim 51 and are patentable for at least the same reasons.

Independent claim 54 has also been amended to recite the first and second engaging members as engaging to prevent release of the boot from the binding during riding, which patentably distinguishes over Bader for the reasons discussed above. As a result, the rejection of claim 54 as being anticipated by Bader should be withdrawn. Claims 55-72 depend from claim 54 and are patentable for at least the same reasons.

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Rejections Under 35 U.S.C. §103 Over Brechet and Romano

In ¶18, a number of claims, including independent claims 1, 33, 51, 54 and 74, are rejected under 35 U.S.C. §103 as being obvious over Brechet in view of Romano. This rejection is respectfully traversed.

Initially, the Office Action characterizes Brechet as being a system wherein the boot may be brought directly downward to engage with the binding. This is incorrect, as the Brechet system includes a stop 10 at the rear of the boot which engages with a stop 8 on the heel hoop of the binding as shown in Fig. 3. Therefore, to step into the binding, the boot cannot simply step straight down into the binding, or the stop 10 would interfere with the highback 3. Therefore, to step into the binding, the rider must angle the stop 10 underneath the stop 8, and only then pivot down the front of the boot to engage the pins 11 at the front of the binding. (See the second full paragraph at page 7 of the translation.)

The Office Action asserts that it would have been obvious to one of ordinary skill in the art to replace the toe end connectors in the Brechet binding with an under-shoe step in attachment system as taught by Romano "for the purpose of decreasing the lateral width of the binding device, and for allowing a simplified insertion-extraction procedure requiring less effort on the part of the operator." (Office Action, page 9). Applicants respectfully disagree.

The purported motivation for making the combination is totally unsupported by the prior art of record, which does not suggest any reason why one would want to decrease the width of the Brechet binding, and which does not indicate that the Brechet binding suffers from an insertion-extraction procedure that requires significant effort on the part of the rider. Therefore, if the rejection over this combination of references is to be maintained, the Examiner is respectfully requested to point to some teaching in the prior art of record that supports the alleged motivation for making the combination. Without doing so, it is respectfully asserted that the Examiner has failed to set forth a *prima facie* case of obviousness.

In addition, Applicants respectfully assert that the combination suggested by the Examiner would actually be inoperative. In this respect, the Examiner asserts that not only would it have been obvious to employ the Romano attachment system in the Brechet binding, but that it further would have been obvious to modify the Romano attachment system so that the engagement loops are located laterally, rather than longitudinally. Thus, the Examiner

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appears to be suggesting that it would have been obvious to employ a forward attachment mechanism such as that disclosed in the present application, wherein the attachment mechanism is disengaged by rotating the heel of the boot forwardly to disengage the boot from the binding. If such a mechanism were employed with Brechet, it would not be possible for the rider to step out of the binding. In particular, Brechet teaches a binding system wherein the heel is attached via the mating of the stops 8 and 10, such that there is no active movable engagement member to release the heel portion of the boot. Rather, the way a rider steps out of the Brechet binding is to first release the toe engagement mechanism, and then to slide the boot forwardly to disengage the stops 8 and 10. (See the third full paragraph at page 7 of the translation). Conversely, the Romano toe attachment mechanism, when modified as suggested in the Office Action, could only be released by detaching the heel of the boot from the binding and then rotating the heel of the boot forwardly. Thus, one of ordinary skill in the art would not have been motivated to employ a forward attachment mechanism such as that taught by Romano in the binding of Brechet, because doing so would result in a binding that could not be exited once a rider had stepped in.

In view of the foregoing, it is respectfully asserted that the combination of Brechet and Romano is improper, so that the rejection of claims 1-13, 15-22, 25, 27, 30-43, 45, 47, 49, 51-64, 66-72 and 74-77 under 35 U.S.C. §103 as being obvious over this combination of references should be withdrawn.

#### Conclusion

In view of the foregoing, it is believed that this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes for any reason that this application is not in condition for allowance, he is respectfully requested to contact the undersigned at the number listed below to discuss any outstanding issues relating to the allowability of the application.

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Respectfully submitted,  
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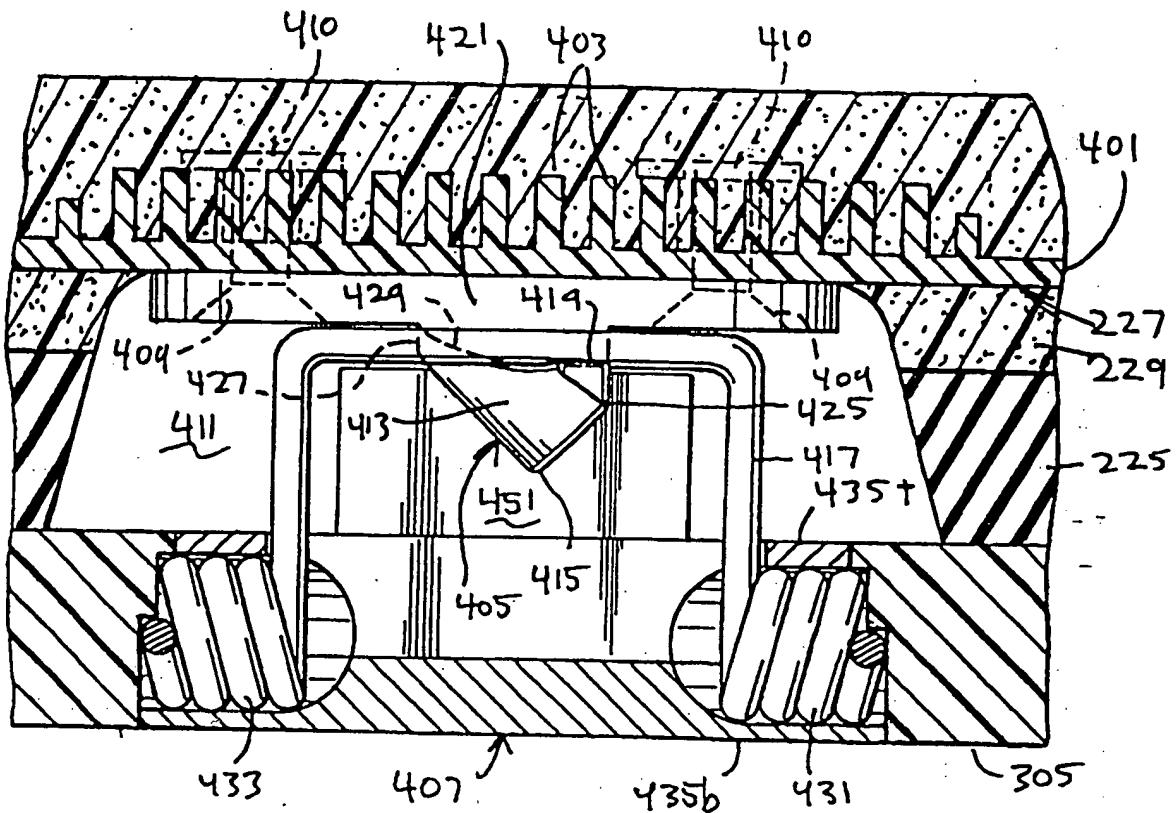


Fig 28

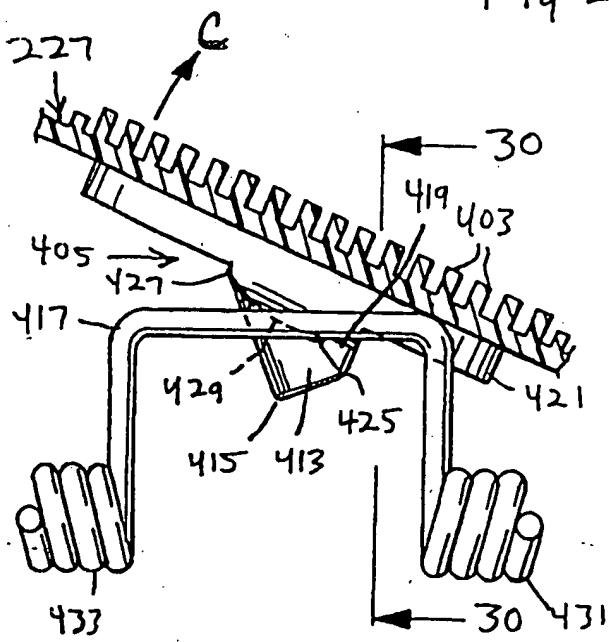


Fig 29

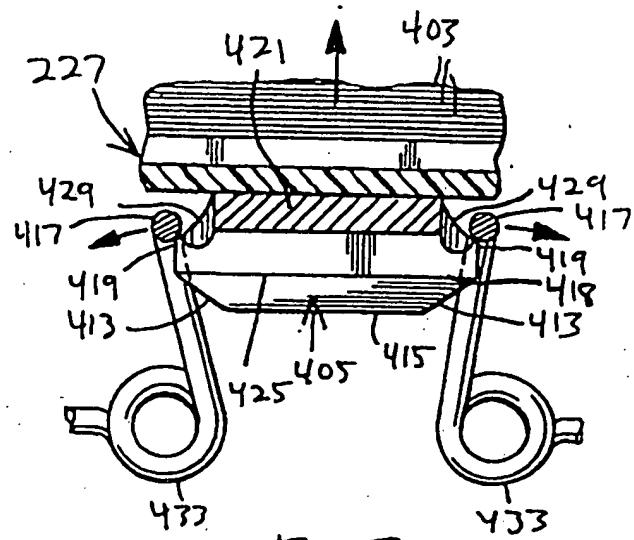


Fig 30